

Application No.: 10/784860

Case No.: 58065US008

REMARKS

Claims 1-7 are pending. Claims 8-17 are withdrawn. Claims 1-7 are rejected. Claim 1 is hereby amended. Claim 4 is hereby cancelled.

§ 102 Rejections

Applicants respectfully submit that according to MPEP 2131 "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citing *Verdegall Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang (PG Pub 2002/0155280 A 1).

The Office Action essentially states:

The applied reference has a common inventor and a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.9.

Applicants have amended claim 1 to remove the reference to liquid crystal polymers.

The cited reference does not disclose a polyimide or polycarbonate film having a reduced thickness. Accordingly, the reference does not describe every element of the claimed invention.

For these reasons, Applicant(s) submit that the cited reference will not support a 102(e) rejection of the claims invention and request that the rejection be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang (PG Pub 2002/0155280 A 1).

The Office Action essentially states:

Claims 1-7 rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The structural limitation of dielectric film having a thickness is reduced from 25-50  $\mu\text{m}$  to less than 10  $\mu\text{m}$  or less, is clearly disclosed in the pre-grant publication (see paragraph 0051). The publication has only one inventor.

Applicants have amended claim 1 to remove the reference to liquid crystal polymers.

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The cited reference does not disclose a polyimide or polycarbonate film having a reduced thickness. Accordingly, the reference does not describe every element of the claimed invention.

For these reasons, Applicant(s) submit that the cited reference will not support a 102(f) rejection of the claims invention and request that the rejection be withdrawn.

### § 103 Rejections

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 6403211).

The Office Action essentially states:

Yang discloses a flexible circuit board comprised of a dielectric film and a copper conductive pattern (col 1 L 10-13). The flexible circuit board is an unsupported cantilevered lead structure (col 2 L 40-41).

The dielectric film can be liquid crystal polymers or polyimides material, etc. (col 2 L 52-56). The copper pattern formed onto the surfaces of the dielectric film (col 6 L 32-42). The dielectric film has an initial film thickness of from about 25-125  $\mu\text{m}$  (col 6 L 18-19).

Yang uses an alkaline etchant which comprises an alkali metal salt and a solubilizer, on the dielectric film for obtaining a desired dielectric film thickness.

Yang teaches the present invention but is silent about the dielectric film is etched to a thickness of less than 20  $\mu\text{m}$  from its original thickness.

However, in view of Yang's teaching, it would have been obvious that Yang's method could produce the same product as claimed by the applicant because the prior art uses the same etchant and same processing steps & conditions as disclosed by the applicant.

In response to the above 102 rejections, Applicants have removed the reference to LCPs from claim 1. Applicants have further amended claim 1 to add the limitation that the reduced thickness is controlled.

Applicants respectfully submit that according to MPEP 2142, to establish a case of prima facie obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicants respectfully submit that the cited reference cannot support a case of prima facie obviousness as to the claims because, among other possible reasons, the reference does not provide a motivation or suggest for reducing to a controlled thickness a polyimide or

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polycarbonate dielectric layer because it teaches away from using a polyimide (col. 1, lines 41-44 and 63-64) and does not mention polycarbonates.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

Claims 1-2 & 5-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-4, and 6-13 of copending Application No. 10/235,465.

The Office Action essentially states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are structurally and materially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicants have executed and enclosed a terminal disclaimer.

For these reasons, Applicant(s) submit that the 103(a) rejection of the claims invention has been overcome.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 102 and 103 is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

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The Examiner is invited to contact Applicant(s)' attorney if the Examiner believes any remaining questions or issued could be resolved.

Respectfully submitted,

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Date

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